REMARKS/ARGUMENTS

This Amendment is in response to the Office Action mailed June 28, 2010 ("the Office Action"). Claims 1-14, 20-23 and 25-31 were pending in the present application. Claims 1-14, 20-23 and 25-31 stand rejected. Specifically, claims 1-14, 20-23, 25 and 27-28 stand rejected under 35 U.S.C. § 103(a) as allegedly being obvious over U.S. Patent No. 7,231,427 to Qiang Du (hereinafter "Du") in view of U.S. Patent Application Publication No. 2007/0005762 by Knox et al. (hereinafter "Knox") and U.S. Patent No. 7,412,437 to Moody et al. (hereinafter "Moody"). Claim 26 stands rejected under 35 U.S.C. § 103(a) as allegedly being obvious over Du in view of Knox, Moody and U.S. Patent Application Publication No. 2004/0006598 by Bargagli Damm et al. (hereinafter "Bargagli Damm"). Claim 29 stands rejected under 35 U.S.C. § 103(a) as allegedly being obvious over Du in view of Knox, Moody and U.S. Patent Application Publication No. 2003/0144903 by Brechner et al. (hereinafter "Brechner"). Claims 30-31 stand rejected under 35 U.S.C. § 103(a) as allegedly being obvious over Du in view of Knox, Moody and U.S. Patent Application Publication No. 2004/0186738 by Richard Reisman (hereinafter "Reisman"). Applicants have carefully considered the Office Action and the references of record. The rejections are respectfully traversed.

In this Amendment, claims 1, 20, 22 and 27-28 are amended, and claims 32-37 are newly added. Support for all amended claims can be found in the specification, and no new matter has been added by these amendments. In view of the following remarks, reconsideration of the rejected claims is respectfully requested.

I.   Independent Claims 1, 20 and 27 Are Allowable Under 35 U.S.C. § 103

Independent claims 1, 20 and 27 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Du in view of Knox and Moody. The Manual of Patent Examining Procedure (M.P.E.P.) states that, to reject a claim under 35 U.S.C. § 103 by combining prior

art elements, the rejection must, at least: (1) show each feature of each rejected claim in the
cited art, with the only difference between the claim and the cited art being the lack of actual
combination of the features in a single prior art reference; (2) show that one of ordinary skill
in the art at the time the invention was made could have made the proposed combination by
known methods, and that, in combination, each feature merely performs the same function as
it does separately; and (3) show that one of ordinary skill in the art at the time the invention
was made would have predicted each result of the proposed combination.

> [The rejection] **must** articulate the following:
>
> (1) a finding that the prior art included **each** element claimed … with the **only**
> difference between the claimed invention and the prior art being the lack of
> actual combination of the elements in a single prior art reference;
>
> (2) a finding that one of ordinary skill in the art could have combined the
> elements as claimed by known methods, and that in combination, each element
> **merely** performs the **same** function as it does separately; [and]
>
> (3) a finding that one of ordinary skill in the art would have recognized that the
> results of the combination were predictable.

(M.P.E.P. § 2143(A), emphasis added). As shown below, the rejection of each claim 1, 20
and 27 under 35 U.S.C. § 103 in the Office Action is deficient in one or more of these
respects and therefore fails to establish a prima facie case of obviousness.

Independent claim 1 is directed to "a method for facilitating and tracking e-mail
communications between (i) an end user … and (ii) an external contact." The method of
claim 1 includes "sending an initial e-mail message … to the external contact." A "REPLY-
TO field of said initial e-mail message" includes "a tracking string encoding tracking
information." Independent claim 1, as amended, requires that the tracking string have "a
plurality of distinct components." A "first component" is required to "[identify] a thread of
conversation between said end user and said external contact." A "second component" is
required to "[order] messages in the thread of conversation independent of message date."

On page 4, the Office Action admits that Du does not teach or suggest the "tracking
string encoding tracking information" required by claim 1. The Office Action then cites

Appl. No. 10/796,718
Amdt. dated September 21, 2010
Reply to Office Action of June 28, 2010

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Knox, ¶ 0006-0007, as teaching "inserting a tracking code into an email." Knox, ¶ 0006-0007, mentions "a tracking code." However, the "tracking code" of Knox is not described as having "a plurality of distinct components" as required by independent claim 1. Furthermore, the "tracking code" of Knox "uniquely identifies the outgoing email." (Knox, ¶ 0017). In contrast, the "tracking string" required by claim 1 includes a "first component uniquely identifying a thread of conversation between said end user and said external contact." Still further, the "tracking code" of Knox is "embedded within an image call." (Knox, ¶ 0006, see also Abstract, ¶ 0019). In Knox, "the image call (and the embedded tracking code) is used to detect when the recipient of the outgoing email has opened that email." (Knox, ¶ 0006) In contrast, the "tracking string" required by claim 1 is incorporated into "a REPLY-TO field of … [an] e-mail message" where an "image call" would be non-functional. Thus, the "tracking code" of Knox and the "tracking string" required by independent claim 1 have different structures, identify different entities, are incorporated differently into messages, and have a different function. Applicants respectfully submit that Knox does not teach or suggest the "tracking string encoding tracking information" required by claim 1 and, in fact, teaches away from independent claim 1.

Also on page 4, the Office Action further admits that the proposed combination of Du and Knox does not teach or suggest "a first tracking string component uniquely identifying a thread of conversation between said end user and said external contact and a second tracking string component that orders messages in the thread of conversation." The Office Action cites Moody, col. 2 ln. 19-33, col. 3 ln. 57-col. 4 ln. 6 and col. 8 ln. 33-39, as teaching this. Moody mentions "conversation threads that include one or more electronic messages that satisfy … [a] search query." (Moody, claim 1). However, Moody nowhere describes "[a] tracking string having a plurality of distinct components including a first component uniquely identifying a thread of conversation between said end user and said external contact" as required by independent claim 1 when read in light of the present specification. Moody, col. 2 ln. 22-26, describes that "the search module determines whether that message

belongs to a thread of messages … the search module retrieves a list of messages related to the message that includes the search terms, from, for example, a threading service," and Moody, col. 3, ln. 57-59, describes that "[the] threading service 110 tracks relationships between various items including messages, documents, and/or other items." However, neither the "search module" nor the "threading service" of Moody teaches or suggests even a tracking string component "uniquely identifying a thread of conversation between said end user and said external contact." This feature of claim 1 is not insignificant and should not be ignored. The nature and function of identifiers can be significant with respect to methods such as those of independent claim 1.

As with claim 1, independent claim 20 is directed to "a method for facilitating and tracking e-mail communications between (i) an end user … and (ii) an external contact." Furthermore, the method of claim 20 includes "sending an initial e-mail message … to the external contact," and requires that the "initial e-mail message" includes "a tracking string encoding tracking information." Independent claim 20, as amended, requires that the encoded tracking information have "a plurality of distinct components including a first component … and a second component." The "first component" is required to "[identify] a thread of conversation between said end user and said external contact," and the "second component" is required to "[order] messages in the thread of conversation independent of message date."

On page 8, the Office Action states that "regarding claim 20, it is similar to claim 1, those similar parts are rejected for the same reasons given in the rejection of claim 1." Applicants respectfully submit that independent claim 20 is distinct from independent claim 1, at least because the language of claim 20 is distinct from the language of claim 1. Nevertheless, some remarks with respect to the proposed combination of Knox, Du and Moody are appropriate.

Independent claim 20 requires that the "encoded tracking information" have "a plurality of distinct components." However, the cited "tracking code" of Knox is not described as having distinct components. Claim 20 requires that the "encoded tracking information" include "a first component uniquely identifying a thread of conversation between said end user and said external contact." However, the cited "tracking code" of Knox "uniquely identifies the outgoing email." (Knox, ¶ 0017). Independent claim 20 requires that the "encoded tracking information" be encoded in a "tracking string" incorporated into a "thread-recurrent field" of an e-mail message. However, the cited "tracking code" of Knox is "embedded within an image call … used to detect when the recipient of the outgoing email has opened that email." (Knox, ¶ 0006). Thus Knox does not teach or suggest the "encoded tracking information" required by claim 20 when read in light of the present specification. Neither does Moody, at least because neither the "search module" nor the "threading service" of Moody teaches or suggests even an encoded tracking information component "uniquely identifying a thread of conversation between said end user and said external contact."

On page 8, the Office Action further states that "thread recurrent fields are disclosed by Knox as subject fields of an email (Fig. 2)." Figure 2 of Knox includes the words "Email Subject", however Knox does not identify the "Email Subject" as a thread-recurrent field, nor does Knox describe embedding the "tracking code" in the "Email Subject". In fact, Knox teaches away by stating that the "tracking code" is "embedded within an image call." (Knox, ¶ 0006).

Independent claim 27 is directed to "a computer-implemented method for facilitating communications between at least a first e-mail user and a second e-mail user." The method of claim 27 includes "sending a first e-mail message … having a first thread-recurrent field encoding tracking information." Independent claim 27 requires that the "tracking information" include "a plurality of distinct tracking information components." A "first tracking information component" identifies "a distinguished communications category of a

plurality of communications categories." A "second tracking information component" identifies "a distinguished thread of communications between at least the first e-mail user and the second e-mail user." The method of claim 27 further includes "evaluating one or more rules to access rules-based e-mail tracking functionality." The evaluation being based on "the distinguished communications category" and "the distinguished thread of communications."

On page 10, the Office Action states that "regarding claim 27, it is similar to claim 1, those similar portions are rejected for the same reasons previously given." Applicants respectfully submit that independent claim 27 is distinct from independent claim 1 at least because the language of claim 27 is distinct from the language of claim 1. Nevertheless, some remarks with respect to the proposed combination of Knox, Du and Moody are appropriate.

Independent claim 27 requires that the "tracking information" have "a plurality of distinct tracking information components." However, the cited "tracking code" of Knox is not described as having distinct components. Claim 27 requires that the "tracking information" include "a second tracking information component uniquely identifying a distinguished thread of communications between at least the first e-mail user and the second e-mail user." However, the cited "tracking code" of Knox "uniquely identifies the outgoing email." (Knox, ¶ 0017). Independent claim 27 requires that the "tracking information" be encoded in a "thread-recurrent field" of an e-mail message. However, the cited "tracking code" of Knox is "embedded within an image call ... used to detect when the recipient of the outgoing email has opened that email." (Knox, ¶ 0006). Thus Knox does not teach or suggest the "tracking information" required by claim 27 when read in light of the present specification. Neither does Moody, at least because neither the "search module" nor the "threading service" of Moody teaches or suggests even a tracking information component "uniquely identifying a distinguished thread of communications between at least the first e-mail user and the second e-mail user."

For at least the above reasons, no combination of Du, Knox and Moody teach or suggest each and every feature of independent claims 1, 20 and 27, as amended. The standing rejections of unamended claims 1, 20 and 27 thus fail to establish prima facie cases of obviousness with respect to independent claims 1, 20 and 27, as amended. Accordingly, Applicants request that the rejections of claims 1, 20 and 27 under 35 U.S.C. § 103 be withdrawn.

II.   Dependent Claims 2-14, 21-23, 25-26 and 28-31 Are Allowable Under 35 U.S.C. § 103

Claims 1, 20 and 27 are in independent form, whereas each of the claims 2-14, 21-23, 25-26 and 28-31 depend on one of the independent claims 1, 20 and 27. The dependent claims are patentable for at least the same reasons that the independent claims are patentable in that the dependent claims incorporate each of the features of the independent claim from which they depend. Nevertheless, the dependent claims further define subject matter not shown or rendered obvious by the prior art of record. Additional reasons for the patentability of the dependent claims 2-14, 21-23, 25-26 and 28-31 exist, and Applicants reserve, without prejudice, the right to provide these reasons at a later date.

CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 206-467-9600.

Respectfully submitted,

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